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Paper No. 9

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MAR 17 2008

OFFICE OF PETITIONS

In re Application of	:	
Robert H. Wake et al.	:	
Application No. 09/816,375	:	DECISION ON PETITION
Filed: March 26, 2001	:	PURSUANT TO
Attorney Docket No. 6573-3	:	37 C.F.R. § 1.181
Title: DETECTOR ARRAY FOR USE	:	
IN A LASER IMAGING APPARATUS	:	

This is a decision on the petition filed on May 14, 2002, and again on September 17, 2007, pursuant to 37 C.F.R. § 1.181, requesting that the holding of abandonment in the above-identified application be withdrawn.

It is clear that in the time between these two filings, a plurality of status inquiries were submitted to the Office.

The Office regrets the period of delay in issuing this decision.

Moreover, the change of correspondence address, submitted on October 6, 2005, has been entered and made of record.

This petition is **DISMISSED**.

BACKGROUND

The above-identified application became abandoned for failure to submit the issue and publication fees in a timely manner in reply to the Notice of Allowance and Issue Fee Due, mailed November 26, 2001, which set a shortened statutory period for reply of three months. No extensions of time are permitted for

transmitting issue or publication fees¹. Accordingly, the above-identified application became abandoned on February 27, 2002. A Notice of Abandonment was mailed on May 1, 2002.

RELEVANT PORTION OF THE M.P.E.P.

M.P.E.P. § 711.03(c) sets forth, *in pertinent part*:

PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement (emphasis added). For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

Two additional procedures are available for reviving an application that has become abandoned due to a failure to reply to an Office Action: (1) a petition under 37 CFR 1.137(a) based upon unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.

¹ See MPEP § 710.02(e).

ANALYSIS

The showing in this petition is not sufficient to withdraw the holding of abandonment. Petitioner has asserted that the Office communication of November 26, 2001 was not received.

It does not appear that Petitioner has provided a statement attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received.

Moreover, it does not appear that Petitioner has provided a copy of the docket record where the nonreceived communication of November 26, 2001 would have been entered had it been received and docketed.

On renewed petition, Petitioner should correct these deficiencies.

Finally, Petitioner has asserted that he reviewed the official file, and "the file showed that the Notice of Allowance was returned to the Office²." The paper file has been reviewed by the undersigned, and it does not appear to contain an indication that the communication of November 26, 2001 was returned to the Office.

If Petitioner is in possession of a paper that would evince the return of the communication of November 26, 2001 to the Office, this should be included on renewed petition.

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.181(a)." This is not a final agency action within the meaning of 5 U.S.C § 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail³, hand-delivery⁴, or facsimile⁵.

2 Petition, received May 14, 2002, page 1.

3 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

4 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

5 (571) 273-8300- please note this is a central facsimile number.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225⁶.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

⁶ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.